

REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1-20 are now present in this application. Claims 1, 11 and 18 are independent.

Amendments have been made to the drawings and to claims 1, 3, 4, 8-14, 16, 18 and 19. No new matter is involved. Reconsideration of this application, as amended, is respectfully requested.

I. Priority Under 35 U.S.C. § 119

Applicant thanks the Examiner for acknowledging Applicant's claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document.

II. Objection to the Drawings

The Examiner has objected to the drawings. The Examiner states that Figure 1 should be labeled --Prior Art--.

In order to address this objection, Applicant respectfully submits that the suggestion in MPEP § 608.02(g) of the use of the phrase --Prior Art-- does not exclude the use of alternate phrases, for example, "Background Art" and "Conventional Art". These alternative phrases may be found in many U.S. Patents issued today. The intent of MPEP § 608.02(g) is to distinguish Applicant's invention from that which is not Applicant's

invention. If a drawing figure illustrates only material which is known to be statutory prior art to the invention, then the use of the phrase --Prior Art-- in the drawing figure would be proper. However, if it is not clear whether such material is statutory prior art, then the use of the phrase --Prior Art-- in the drawing figures would not be proper, and a label such as "Background Art" or "Conventional Art" would be more appropriate.

Applicant submits, because Fig. 1 is clearly designated in the specification as "conventional art", that the proposed drawing corrections filed herewith, including labeling Fig. 1 as "Conventional Art", meet the criteria of MPEP § 608.02(g) and are sufficient to distinguish Applicant's invention from that which is not Applicant's invention. Accordingly, reconsideration and withdrawal of this objection, and approval of the proposed drawing corrections filed herewith, are respectfully requested.

III. Claim Objections

The Examiner has objected to claims 8, 9, 11, 16, 18 and 19 because of several informalities. In order to overcome this objection, Applicant has amended claims 8-14 and 18 in order to correct the deficiencies pointed out by the Examiner. Reconsideration and withdrawal of this objection are respectfully requested.

IV. Claim Amendments

Applicant has amended the claims in order to correct minor typographical errors, and to place the claims in better form. The claim amendments are not being made in response to any statutory requirement for patentability, and have not been narrowed in scope. Instead, the claims have been amended merely to recite the subject matter therein more clearly.

V. Rejections under 35 U.S.C. §103

Claims 1-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the allegedly Admitted Prior Art of Figure 1 in view of U.S. Patent 5,862,412. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

At the outset, no admission has been made by Applicant that Figure 1 qualifies as statutory prior art usable in a rejection of the claims of the present application. Instead, Applicant has labeled Figure 1 as "Conventional Art" to distinguish Applicant's invention from that which is not Applicant's invention. If a drawing figure illustrates only material which is known to be statutory prior art to the invention, then the use of the phrase --Prior Art-- in the drawing figure would be proper. However, if it is not clear whether such material is statutory prior art, then the use of the phrase --Prior Art-- in the drawing figures

would not be proper, and a label such as "Conventional Art" would be more appropriate to distinguish Applicant's invention from that which is not Applicant's invention.

In rejecting claims under 35 USC 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the

manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish prima facie obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

The first requirement is a showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, obviousness of an invention cannot be established by combining the teachings of the prior art absent some teaching, suggestion or incentive supporting the combination (see, for example, ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

According to the Office Action, the alleged reason to modify the conventional art of Fig. 1 "by providing the character and picture data compression/decompression apparatus of Sugiyama" is "so that the compressed bit map data takes less memory to store, thereby making the system less costly and a more compact system over all."

However, this alleged motivation is nothing more than a broad conclusory statement about compression and decompression of bit map data which did not motivate the developers of the conventional art to modify the conventional art and does not constitute "evidence" of proper motivation to make the alleged modification of the conventional art- see Dembiczak, cited above, in this regard.

The Office Action does not make out a prima facie case of obviousness of the claimed invention at least for this reason.

Moreover, one of ordinary skill in the art would have no incentive to modify the conventional art, which is directed to an image display device in a digital TV that receives TV broadcasts and provides various resolutions of broadcast text data by storing a number, e.g., four, of different text resolutions and then displaying a predetermined stored text resolution in view of Sugiyama because Sugiyama is not concerned with digital TVs that receive TV broadcasts at all, or digital TVs that receive TV broadcasts and convert text data into the display format according to the variation of resolution.

Rather, Sugiyama is directed to "development of a portable terminal equipment wherein character data and/or picture data of binary or multiple values of characters, line drawings, photographs and so forth recorded in a book, a newspaper, a magazine or the like are recorded onto an electronic, optical or magnetic recording medium." See col. 1, lines 15-21. Sugiyama is concerned with "document data", and is not concerned with digital TVs that receive TV broadcasts.

The Office Action fails to explain why one of ordinary skill in the art would look to Sugiyama to modify the convention TV display for TV broadcasts. The only reason one might do this is based on Applicant's disclosure, but that is impermissible hindsight reconstruction of the claimed invention based solely on Applicant's disclosure.

Furthermore, there is no indication of record that the conventional art has a problem to be solved. So, one of ordinary skill in the art would not be looking around for a solution to a problem of which the skilled worker is not aware.

The only indication of the problem is by Applicant in his disclosure, and his disclosure cannot be used against him as it is impermissible hindsight. In this regard, it should be noted that Applicant does not state that the conventional art recognized that a problem existed that needed to be solved.

Moreover, there is certainly no disclosure in evidence of a problem with TV displays for broadcast TVs that is addressed by

Sugiyama, which is directed to display terminals for character and/or picture data that are recorded onto an electronic, optical or magnetic recording medium.

Accordingly, the rejection fails to make out a prima facie case of obviousness of the claimed invention.

Regarding claim 5, which depends from claim 1, the Office Action provides no evidence of the speculation in which it engages. Neither the conventional art nor Sugiyama discloses or suggests converting text data to bit map format if it is determined not to be in bit map format. Logically, nothing comes from nothing, so that because neither reference discloses or suggests the claimed feature, logically, neither or both references can render obvious this claimed feature, which is not found in either one. Moreover, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusionary statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). As neither applied reference even suggests converting text to bit map form if it is determined not to be in bit map form, the motivation for modifying one of the two references to include that feature must be based on speculation and/or impermissible hindsight.

Similar comments apply to the rejection of claim 6, which recites a feature not found in either applied reference.

With respect to claim 7, the question is not whether run-length encoding is well known in the art, but whether it would be obvious to apply run-length encoding to the applied reference combination. The Office Action alleges that it would be obvious to do so "so that the DC-balancing or DC wondering of the signal would greatly improve."

Unfortunately, the Office Action fails to present any objective evidence in support of this conclusion - evidence that is required to be presented. See, in this regard, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Accordingly, this rejection of claim 7 is fatally defective and must be withdrawn.

Similar comments apply to the rejection of claim 9 with respect to which the Office Action fails to present any objective evidence in support of its conclusion that it would be obvious to further modify the system of conventional art and Sugiyama by providing a consecutive bit map conversion process so that conversion from text or document data would be less prone to error and as a result run more smoothly. This is another rejection based on improper speculation and on references that simply fail to disclose or suggest the features recited in claim 9.

For the aforementioned reasons, Applicant respectfully submits that the office Action fails to make out a prima facie

case of obviousness of the claimed invention recited in claims 1-9.

Reconsideration and withdrawal of the rejection of claims 1-9 under 35 USC §103(a) as unpatentable over the conventional art of Fig. 1 in view of Sugiyama is respectfully requested.

Claims 11-16, 18 and 19 stand rejected under 36 USC 103(a) in view of Sugiyama in view of U.S. Patent 5,969,770 to Horton. This rejection is respectfully traversed.

In the first place, Sugiyama does not disclose a "digital TV having a display" as recited. All that Sugiyama discloses is "a portable terminal" (col. 1, lines 15-20). Not once does Sugiyama disclose a digital TV, either expressly or inherently (which means it must necessarily be disclosed).

In the second place, as clearly, unmistakably and unequivocally admitted in the Office Action, Sugiyama does not disclose a format converter for converting the format of the decompressed bit map data to correspond with display resolution.

In the third place, Horton does not disclose a format converter for converting the format of the decompressed bit map data to correspond with display resolution, either. Instead, Horton merely discloses conversion between unsampled graphics information made up of a complete set of luminance and chrominance components (e.g., 4:4:4) and subsampled graphics information made up of less than complete sets of luminance and chrominance

components (e.g., 4:2:2 and/or 4:2:0), which has nothing to do with display resolution.

So, even if these two references were combined, as alleged, they would not result in the claimed invention.

Moreover, the Office Action fails to explain why one of ordinary skill in the art would be motivated to use Horton's digital satellite television system using packet streams which does not address changing display resolution to modify Sugiyama, which also does not disclose or suggest changing display resolution, and is directed to development of portable terminal equipment not disclosed as dealing with packet streams to achieve a feature that neither reference discloses or suggests, namely changing display resolution for text data.

With respect to claims 13, 14, 15 and 16, Applicant respectfully submits that these claims are also not obvious at least for the reasons stated above regarding claim 11. Additionally, these claims are not obvious at least for reasons similar to those presented above regarding the rejections of claims 5, 6, 7 and 9.

With respect to claim 18, please see the above remarks regarding the traversal of the rejection of claim 11. Those remarks apply equally to the rejection of claim 19.

With respect to claim 19, please see the above remarks regarding the traversal of the rejection of claim 16 (which refers

to the arguments presented in the traversal of the rejection of claim 9).

Accordingly, Applicant respectfully submits that the Office Action fails to make out a prima facie case of obviousness of the claimed invention recited in claims 11-16, 18 and 19.

Reconsideration and withdrawal of the rejection of claims 11-16, 18 and 19 under 37 USC §103(a) as unpatentable over Sugiyama in view of Horton is respectfully requested.

VI. Allowable Subject Matter

The Examiner states that claims 10, 17 and 20 would be allowable if rewritten in independent form.

Applicant thanks the Examiner for the early indication of allowable subject matter in this application.

As set forth above, Applicant believes that claims 1, 11 and 18 from which claims 10, 17 and 20 respectively depend are allowable and therefore, claim 10, 11 and 17 should be in condition for allowance.

VII. Additional Cited References

Since the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

VIII. Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

Application No.: 09/922,863

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachments: Replacement Drawing Sheet
Annotated Drawing Sheet